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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,013	01/29/1999	YOICHI TAKARAGI	35.G2349	5593

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NEW YORK, NY 10112

EXAMINER

AHMED, SAMIR ANWAR

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 10/06/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/239,013

Applicant(s)

YOICHI TAKARAGI

Examiner

Samir A. Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-15,17-19,21-26 and 28-40 is/are pending in the application.

4a) Of the above claim(s) 30-40 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15,17-19,21-26,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The suspension for 3 months starting 4/18/03 has ended.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/18/03 has been entered.
3. Applicant's arguments filed 4/18/03 have been fully considered but they are not persuasive with regard to claims 1, 8, 15, 19 and 26 for the following reasons:

As to claim 1, the Applicant alleges that "Applicant strongly asserts that nothing in Funada teaches or suggests [,]" (page 10, line 16-page 11, line 2). The Examiner disagrees. Firstly, the color tone in Funada identifies particular kinds of originals such as confidential papers and the like (i.e., identification information), that cannot be copied based on that color tone (i.e., the color tone is related to copyright) which reads on that limitation as broadly claimed. Secondly, the types of documents referred to are ones whose copying is prohibited based on statutes to prevent counterfeiting, forgery, confidentiality violation [confidential papers (col. 6, lines 19-20, Fig. 17A)], prohibiting confidential papers copying relates to copyright protection. Thirdly, Funada clearly discloses that the present invention is applicable no matter what the concept of "a particular kind of original" (col. 12, lines 64-68), i.e., the particular kind of original could be any document whose copying is prohibited based on statutes to prevent any type of violation, such as counterfeiting, forgery, confidentiality violation, copyright violation.

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Fourthly, claim 1 states the first identification information relating to a copyright, and does not state the first identification information conveying a copyright.

Applicant alleges that "Further, the Examiner [,]" (page 11, line 3-page 12, line 6). The Examiner disagrees. Funada teaches adding a particular pattern with yellow toner or other colors such as yellowish green gray, light violet and light green (col. 19, lines 18-23) that is difficult to discriminate with human eye (second identification information not easily recognizable with eye) upon detecting a color tone that relates to copyright which is easily recognizable to the eye (first identification information relating to copyright) on a document. Wen discloses that it is well known to hide copyright information to be not easily recognized with the eye by generating the information in yellow at low intensity and print it on the document. One of ordinary skill in the art at the time of the invention would hide the information relating to copyright in Funada as taught by Wen in order to prevent easy detection, and modification of the information, deter and reduce copyright violations.

Claim Rejections - 35 USC ' 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 3-8, 10-15, 17-19, 21-26, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funada (U.S. patent 5,257,119) in view of Wen (U.S. patent

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5,822,660). The grounds for rejections stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 1, refer to claim 2 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 8, refer to claim 9 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 15, refer to claim 16 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 19, refer to claim 20 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 25, refer to claim 26 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

5. This is a continuation of applicant's earlier Application No. 09/239,013. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

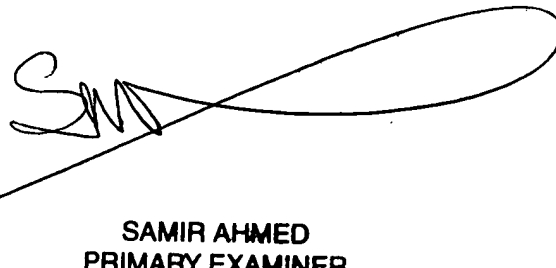
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir Ahmed whose telephone number is (703) 305-9870. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au, can be reached on (703) 308-6604. The fax phone number for this Group is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SA

10/01/03



SAMIR AHMED
PRIMARY EXAMINER